

## **REMARKS**

The Examiner is thanked for the thorough examination of this application. The Office Action, however, objected to claims 1 and 11 for certain informalities, and rejected claims 1-19 under 35 U.S.C. § 112, second paragraph. The Office Action also rejected claims 1-3, 5-12 and 15-21 under 35 U.S.C. § 103(a) as allegedly unpatentable over Jones et al (US Patent No. 6,438,638) in view of Okada et al. (US Patent 6,374,315). For the reasons set forth hereinafter, Applicant respectfully requests reconsideration and withdrawal of the rejections.

### **I. Discussion of Objection of the specification and the title**

The title as filed is objected to no being not descriptive. The Applicant has changed to the title to “multiple format interface adapter for small storage media”, as suggested by the Examiner. Accordingly, the objection should be withdrawn.

As to the trademarks or proper names used throughout the specification, Applicant has amended the specification to replace these terms with corresponding generic terminology. The amendments to the specification do not impart substantive changes, and therefore do not add any new matter to the application.

### **II. Discussion of Rejections Under 35 USC 112**

Claims 1-19 were rejected because they contained certain trademarks/trade names. Applicants have amended the claims to remove the use of the trademark from the claims. These amendments add no new matter to this application and should be entered. Withdrawal of these rejections is respectfully requested.

### III. Discussion of Rejection of Claims 1-19 under 35 U.S.C. § 103(a)

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as allegedly anticipated by Mowery et al in view of Jones et al. Applicants respectfully request reconsideration and withdrawal of this rejection, in view of the amended claim language of the various independent claims (and the cancellation of independent claim 10).

Independent claim 1, as amended, recites:

1. A multiple format interface adapter for small storage media, comprising:  
a storage media interface, connected to a plurality of storage media cards  
*two-system end-interfaces compatible with different interface format, coupled to the storage media card interface, wherein one of the system-end interfaces cooperates with the storage media card interface when one storage media card inserts and interfaces to a system end for data transmission.*

*(Emphasis added.)* Claim 1 patently defines over the cited art for at least the reason that the cited art fails to disclose the features emphasized above.

As illustrated in each of FIG 4 and FIG. 7 of the present application, the adapter has two “CONN”s, which means there are two interfaces compatible with different standards for host connector (such as USB and PCI). For those skilled in the art, it is well known that one CONN shown in the circuit layout is used to connect to a corresponding connector port of a host.

It is noted that, in order to make the terminology of “two-configuration connector interface” clearer in the claims, the applicant changed the term “two-configuration connector” in the amended claims to “two-system end-interfaces”. Such a change in terminology does not add any new matter to the application, as the language was clearly supported by the original specification and drawings.

In contrast to the claimed embodiments, Mowery discloses only a passive socket having a plurality of media card connectors, and a host connector connected to the media card connectors

and a connector of the host computer, wherein the connector of the host computer conforms to a PCMCIA standard. Significantly, however, Mowery fails to teach or suggest the claimed features of either two-system end-interfaces compatible with different interface standards, or a signal converter control chip between an USB interface and a storage media card interface.

The Office Action has misconstrued the IDE 51 as shown in FIG. 3B in Jones as signal converter control chip of claimed invention. Applicant respectfully points out that Jones' CompactFlash system 42 interfaces to CompactFlash 49, 51 and PCMCIA 53 on an output side [0050], used to connect to a CompactFlash, PCMCIA or IDE port [0073]. This structure and interconnection is different from the claimed embodiments of the signal converter control chip. In one of the embodiments of the claimed invention, an IDE converter control chip is configured to convert storage medium-compatible USB signals to system-compatible IDE signals [0009], rather than just a port as taught by Jones.

Accordingly, the teachings of Mowery and Jones do not disclose, and in fact teach away from, the claimed invention, and therefore even if combined, their collective teachings do not render the claimed invention unpatentable. For at least this reason, independent claim 1 patently defines over the cited art. Dependent claims 1-4, 7-8, 12, 16-17 and newly added dependent claims 20-21 define over the cited art for at least the same reasons.

As a separate and independent basis for the patentability of independent claim 1, Applicants respectfully submit that there is no proper basis for selectively combining teachings from Mowery and Jones in the manner alleged by the Office Action.

It is well settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art

that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock  
Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991).

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro  
Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

## CONCLUSION

For at least the foregoing reasons, it is believed that all of the pending claims 1-4, 7-8, 12, 16-17 and new claims 20-21 of the present application patently define over the prior art and are in proper condition for allowance. If the Examiner believes that a telephone conference would

expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

If Examiner has any questions regarding this filing or the application in general, Examiner is invited to contact the undersigned at 770-933-9500.

#### **AUTHORIZATION TO DEBIT ACCOUNT**

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

Respectfully submitted,



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